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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,539	09/03/2004	Masahiro Konishi	Q83055	1215

23373 7590 09/28/2005
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EXAMINER

EDWARDS, NEWTON O

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/506,539

Applicant(s)

KONISHI ET AL.

Examiner

N Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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1. Claims 8-10 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 8-10 have not been further treated on the merits.

2. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4, line 4 "monoalkyl phosphates" is vague and indefinite as to the meaning of the phrase as it relates to formula IV. It appears that applicant is calling R^2O in formula IV a monoalkyl phosphates. This is incorrect. Formula IV R^2O is alkoxy. Correction is required.

3. The disclosure is objected to because of the following informalities: All occurrence of monoalkyl phosphates in the spec should be changed to alkoxy phosphates. See pages 13 and 14 of the spec for example.

Appropriate correction is required. The correction will place your case in a better condition for allowance.

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4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to for failing to provide an adequate written description of the invention.

The specification as filed fails to set forth 1) what defines or constitute a monoalkyl phosphates (in formula 4).

Claim 4 is rejected under 35 U.S.C. 112, first paragraph, for the reason given in the objection above.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto (US 6,593,447) taken with Suzuki (US 5,331,032).

For the record, this reject is applied only because applicant spec and claim is calling R^2O in Formula IV a monoalkyl phosphates.

Yamamoto, a Teijin Patent, teaches polyester filaments comprising a polyester polymer and a catalyst. Yamamoto further teaches the catalyst includes a reaction product and/

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or mixture of a titanium alkoxides as claimed, aromatic poly-carboxylic acids as claimed and a phosphorus compound (formula IV) having monoalkyl phosphates. See the abstract and column 1 of Yamamoto, for example. Yamamoto teaches all of the claimed invention except the fiber thickness of 0.1 to 1.0 dtex. See Yamamoto column 6 lines 50-57 for claim 2, column 8 lines 1-25 for claims 5 and 3, column 8 lines 60-end for claim 6, column 5 formula 3 for claim 4, example for claim 7.

Suzuki, a Teijin patent, teaches it is well known in the art of polyester fiber of vary and control the fiber fineness (denier) to 1 or less without breaking in order to making the fiber durable, see claim 8 and column 1 of Suzuki.

Thus it would have been obvious to one having ordinary skill in the art to incorporate the denier, as taught by Suzuki, in the polyester fiber as taught by Yamamoto in order to avoid breakage and make the fiber durable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to N Edwards whose telephone number is 571-272-1521. The examiner can normally be reached on Monday-Friday from 6:00am to 2:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'N Edwards', is positioned above the printed name.

N Edwards
Primary Examiner
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